

REMARKS

The Office Action mailed April 18, 2005, has been received and reviewed. Claims 1 through 48 are currently pending in the application, of which claims 1 through 5, 10 through 15, 20, 39 through 43 and 48 are currently under examination. Claims 6 through 9, 16 through 19, 21 through 38 and 44 through 47 are withdrawn from consideration as being drawn to a non-elected invention and have been canceled. Claims 1, 2, 5, 11, 12, 15, 39, 40 and 43 stand rejected. Applicants have amended claims 1, 3, 4, 10, 11, 13, 14, 20, 39, 41, 42, and 48, and respectfully request reconsideration of the application as amended herein.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 4,008,300 to Ponn

Claims 1, 5, 11 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ponn (U.S. Patent No. 4,008,300). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants submit that the Ponn reference does not and cannot anticipate under 35 U.S.C. §102 the presently claimed invention of amended independent claims 1 and 11 and claims 5 and 15 respectively depending therefrom because the Ponn reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims. Ponn discloses an:

elastomeric retainer or base 12 [] cured and has in its pre-use finished form, a series of parallel holes 14 extending from one flat surface to the other. In these holes are lengths or rods 16 of resilient electrically conductive material 18, with each such conductor having slight convex bulges 19 or protrusions at its respective ends thus at both sides of the base 12. Ponn, col. 3, lines 8-14).

More specifically, Applicants submit that the Ponn reference does not describe among other things, either expressly or inherently, the elements of the claimed invention of presently amended independent claims 1 and 11 calling for a **“substrate further configured to receive therein at least a portion of the at least one laterally unsupported portion when the at least one laterally unsupported portion flexes”**.

Therefore, presently amended independent claim 1 and 11 and claims 5 and 15 respectively depending therefrom are not anticipated by the Ponn reference under 35 U.S.C. §102 as being unpatentable over the Ponn reference. Therefore, Applicants respectfully request that the rejections be withdrawn.

Anticipation Rejection Based on U.S. Patent No. 5,785,538 to Beaman et al.

Claims 39 and 43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Beaman et al. (U.S. Patent No. 5,785,538). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants submit that the Beaman reference does not and cannot anticipate under 35 U.S.C. §102 the presently claimed invention of amended independent claim 39 and claim 43 respectively depending therefrom because the Beaman reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims. Beaman discloses an:

As the high density probe (10) is pressed against the IC device (20), the polymer mask (18) presses against the layer of elastomer material (17) and forces the ball shaped ends (16) of the probes through the slotted openings (19) in the polymer mask (18). The wiping action of the probe is caused by the ball shaped contact (16) pressing against and sliding along the surface (23) of the bond pad (21). The length of the wiping action is restricted by the size of the slotted hole (19) in the polymer mask(18). Col. 3, lines 34-42).

More specifically, Applicants submit that the Beaman reference does not describe among other things, either expressly or inherently, the elements of the claimed invention of presently amended independent claim 39 and claim 43 depending therefrom calling for a **“substrate further configured to receive therein at least a portion of the at least one laterally unsupported portion when the at least one laterally unsupported portion flexs”**.

Therefore, presently amended independent claim 39 and claim 43 respectively depending therefrom are not anticipated by the Beaman reference under 35 U.S.C. §102 as being unpatentable over the Beaman reference. Therefore, Applicants respectfully request that the rejections be withdrawn.

Anticipation Rejection Based on U.S. Patent No. 5,785,538 to Beaman et al.

Claims 1, 5, 11 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Beaman et al. (U.S. Patent No. 5,785,538). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants submit that the Beaman reference does not and cannot anticipate under 35 U.S.C. §102 the presently claimed invention of amended independent claims 1 and 11 and claims 5 and 15 respectively depending therefrom because the Beaman reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims. Beaman discloses an:

As the high density probe (10) is pressed against the IC device (20), the polymer mask (18) presses against the layer of elastomer material (17) and forces the ball shaped ends (16) of the probes through the slotted openings (19) in the polymer mask (18). The wiping action of the probe is caused by the ball shaped contact (16) pressing against and sliding along the surface (23) of the bond pad (21). The length of the wiping action is

restricted by the size of the slotted hole (19) in the polymer mask(18). Col. 3, lines 34-42).

More specifically, Applicants submit that the Beaman reference does not describe among other things, either expressly or inherently, the elements of the claimed invention of presently amended independent claims 1 and 11 and claims 5 and 15 depending therefrom calling for a **“substrate further configured to receive therein at least a portion of the at least one laterally unsupported portion when the at least one laterally unsupported portion flexes”**.

Therefore, presently amended independent claims 1 and 11 and claims 5 and 15 respectively depending therefrom are not anticipated by the Beaman reference under 35 U.S.C. §102 as being unpatentable over the Beaman reference. Therefore, Applicants respectfully request that the rejections be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 4,008,300 to Ponn

Claims 2 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponn (U.S. Patent No. 4,008,300). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 2 and 12 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the

rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding claims 2 and 12, which depends from amended independent claim 1, Applicants sustain the above-proffered arguments that Ponn does not teach, disclose or motivate Applicants' invention as claimed in amended independent claim 1 and 11. The Office Action alleges:

As to claims 2, 12, the cross section of the compliant contact of Ponn is not a rectangular shape. However, it would have been obvious for one of ordinary skill in the art to make the compliant contact of Ponn in rectangular shape, this is an obvious design choice . . . (Office Action, p. 4).

Even assuming *arguendo*, that a rectangular shape is an obvious design choice, the Ponn reference does not teach, disclose or motivate Applicants' invention including the claim limitations of **“substrate further configured to receive therein at least a portion of the at least one laterally unsupported portion when the at least one laterally unsupported portion flexes”**.

Therefore, Applicants respectfully request that the rejection of dependent claims 2 and 12 be withdrawn.

Obviousness Rejection Based on U.S. Patent No. 5,785,538 to Beaman et al.

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaman et al. (U.S. Patent No. 5,785,538). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.

1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejection of claim 40 is improper because the elements for a prima facie case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding claim 40, which depends from amended independent claim 39, Applicants sustain the above-proffered arguments that Beaman does not teach, disclose or motivate Applicants' invention as claimed in amended independent claim 39. The Office Action alleges:

As to claim 40, the cross section of the compliant contact of Beaman et al is not a rectangular shape. However, it would have been obvious for one of ordinary skill in the art to make the compliant contact of Beaman et al in rectangular shape, this is an obvious design choice (Office Action, pp. 4-5).

Even assuming arguendo, that a rectangular shape is an obvious design choice, the Beaman reference does not teach, disclose or motivate Applicants' invention including the claim limitations of **“substrate further configured to receive therein at least a portion of the at least one laterally unsupported portion when the at least one laterally unsupported portion flexes”**.

Therefore, Applicants respectfully request that the rejection of dependent claim 40 be withdrawn.

Objections to Claims /Allowable Subject Matter

Claims 3, 4, 10, 13, 14, 20, 41, 42 and 48 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form.

Applicants have amended claims 3, 4, 10, 13, 14, 20, 41, 42, and 48 into independent form. Applicants respectfully request the objection be withdrawn.

CONCLUSION

Claims 1-5, 10-15, 20, 39-43, and 48 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. The amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'K. Johanson', with a long horizontal flourish extending to the right.

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